

Appl. No. 09/833,278

REMARKS/ARGUMENTS

Applicants request this Amendment be entered to place the application in condition for allowance or better form for appeal.

Applicants' invention is directed to a method for adhesively joining or sealing two substrates using a controlled structure polyisocyanate prepolymer composition based on 4,4'-diphenylmethane diisocyanate (MDI) reacted with a polyol composition comprising a propylene oxide based polyether polyol (PPG). Such MDI based prepolymer composition has low levels of oligomers and residual MDI monomer, i.e., the polyisocyanate prepolymer reaction product consists essentially of at least 80 wt% of a stoichiometric "perfect" prepolymer (≤ 20 wt% oligomers) and contains less than 2 wt% unreacted MDI monomer. Applicants' claims define the required perfect prepolymer content and the required low level of unreacted MDI monomer of the polyurethane prepolymer composition for affording the advantages as stated at page 5/1-12. Such advantages include improved green strength, improved ambient development of strength, and laminating adhesives showing longer pot lives while maintaining faster development of adhesive strength. Such advantages are demonstrated in Applicants' Examples 5, 6, and 7 using the MDI/PPG-based prepolymer compositions of Examples 1-4.

Status of Claims

Claims 21-36 are pending.

Claims 21 and 31 have been rejected.

Claims 22-30 and 32-36 have been objected to.

Claims 1-20 have been canceled.

Applicants acknowledge that the objection of the abstract has been withdrawn.

Claims 34-36 have been objected to because they were dependent on a canceled claim. Claim 34 has been amended so that it and Claims 35-36 depend from a pending claim.

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Claims 21 and 31 were rejected under 35 USC 112, first paragraph, because the specification does not reasonably provide enablement for all substrates in the field of chemistry.

Applicants contend that this rejection by the Examiner is without merit. To reiterate the relevant field of the invention and the substrates used therein is not all of chemistry but rather the field of joining or sealing substrates with adhesives. Moreover, Claims 21 and 31 are written in Jepson format. In the conventional Jepson claim, the portion of the claimed subject matter which relates to the prior art is placed in the preamble. Rule 75(e) of the Rules of Practice states that "where the nature of the case admits, as in the case of an improvement . . . those elements or steps of a claimed combination which are conventional or known should be recited in a preamble which is followed by a recitation of the portion of the invention which the applicant considers new or improved." Applicants are not required to include in the specification that which is known in the art of joining and sealing substrates with adhesives. Those in the art know which substrates to use and the conditions under which to practice the method joining or sealing such substrates. It is the improved adhesive composition which must be enabled to the worker of ordinary skill in the art. The Examiner has made no rejection based on lack of enablement regarding the polyurethane adhesive composition.

MPEP 2164.01 – Test of Enablement

"Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention."

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."

"A patent need not teach, and preferably omits, what is well known in the art." *In re Buchner*, 18 USPQ2d 1331, 1332 (Fed Cir. 1991)

The Jepson-type claims 21 and 31 omit what is well known in the pertinent art of adhesively joining or sealing substrates. The specification need not disclose such information.

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Nevertheless, Applicants at page 4/16-24 have broadly disclosed how to adhesively join or seal two substrates using the MDI/PPG-based prepolymer compositions as adhesives and in the examples Applicants have shown specifically how to join or seal two such substrates. Such teaching is applicable to all the substrates in the field of adhesively joining or sealing films and sheets. The disclosure is written to a worker of ordinary skill in the art and in the art of adhesives used for joining substrates such as films and sheets, the skilled worker well knows how to use the adhesive compositions and the substrates to be used in his application.

Applicants are unaware of any legal requirement that a certain minimum number of working examples are necessary to satisfy the enablement requirement. A disclosure which contains representative examples which provide reasonable assurance to one skilled in the art that the compounds falling within the scope of a claim will possess the alleged utility is all that is required, when there is no reason to suspect the assertions are not accurate. *In re Barr et al*, 170 USPQ 330 (CCPA 1971). An applicant need not provide a specific example of everything embraced by a broad claim. *In re Anderson*, 176 USPQ 331 (CCPA 1973). The number and variety of examples are irrelevant if the disclosure is "enabling" and sets forth the "best mode contemplated". Although at one time the PTO required at least one "working" example as part of the disclosure of the specification, there is no absolute statutory requirement for such an example if the disclosure is such that one skilled in the art can practice the claimed invention. *In re Borkowski et al*, 164 USPQ 642 (CCPA 1970). The PTO has the burden of showing that the disclosure entails undue experimentation. *In re Angstadt*, 190 USPQ 214 (CCPA 1976). Absent a reason why such teaching is not applicable to all substrates in the field of the invention, the Examiner must accept that §112, first paragraph is satisfied.

Accordingly, Applicants submit that the skilled worker knows any solid substrate as used in the art can be joined or sealed merely by applying the adhesive composition to at least one substrate surface and contacting the adhesive composition on the substrate to a second substrate surface of same or different material such that a bond is formed. The first substrate can act as the second when it is folded for joining or sealing. Applicants submit Examiner has failed to meet his burden of establishing that such disclosure by Applicants in combination with that which is already known in the art does not enable Claims 21 and 31. Broad, conclusional statements that §112 is not satisfied do not meet the Examiner's burden.

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Most perplexingly, the Examiner has only objected to Claims 22-30 and 32-33 as depending from a rejected claim. Presumably, then the specification satisfies §112, first paragraph, as to Claims 22-30 and 32-33 whereas, according to the Examiner, Claims 21 and 31 from which they depend are not enabled. Claims 22-30 and 32-33 do not add any limitation or language that would overcome the Examiner's alleged deficiency of the specification as to Claims 21 and 31 under §112, first paragraph.

Applicants request reconsideration and withdrawal of the 112, first paragraph, rejection.

Applicants acknowledge that the rejection under 35 USC 103(a) as being unpatentable over EP 0827995 (McInnis) has been withdrawn. The Examiner has again incorrectly cited EP '995 as "Lee et al".

Believing the Application is in condition for allowance, Applicants solicit an action to that effect. Should the Examiner not issue an allowance of all the pending claims, Applicants respectfully request a telephone conference with the Examiner and his supervisor to discuss Applicants' prosecution options.

Respectfully submitted,



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